

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed July 11, 2006. Claims 9, 12, and 30 are amended. Claims 1-34 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. Allowed Subject Matter

The Examiner's allowance of claims 16-20, and indication of allowable subject matter set forth in claims 3-6 and 12 is appreciated. Applicants wish to thank the Examiner for the careful review of those claims.

The Applicant's submit the following comments concerning the Examiner's statements of reasons for the indication of allowable subject matter in the Office Action. Applicant agrees with the Examiner that the claimed invention of claims 3-6, 12, and 16-20 is patentable over the prior art, but respectfully disagrees with the Examiners statement of reasons for allowance as set forth in Office Action. Applicant submits that it is the claim as a whole, rather than any particular limitation, that makes each of the claims allowable. No single limitation should be construed as the reason for allowance of a claim because it is each of the elements of the claim that makes it allowable. Therefore, Applicant's do not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, the claims allowable and do not make any admission or concession concerning the Examiner's statement in the Office Action.

II. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. §102(e)

Examiner rejects claims 1, 2, 7, 9-11, 13-14, 22-25, 27-32, and 33 under 35 U.S.C. § 102(e)¹ as being anticipated by *Tsuda et al* (United States Patent No. 6,931,752). Because *Tsuda* does not teach or suggest each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

A claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *Manual of Patent Examining Procedure* (“MPEP”) § 2131.

According to the Examiner on page 3, *Tsuda* discloses “At least one rotation paddle [see paddle attached to the component 5]; and Means [see the mechanism of the movement of element 5] for engaging the at least one rotation paddle to selectively rotate the alignment carriage.”

In direct contrast to the characterization of *Tsuda* set forth by the Examiner, the second stage component 5 referred to by the examiner is engaged by a movement mechanism to move the second stage 5 in a second linear direction in the Y axis direction (as opposed to rotationally as alleged). Col. 4, lines 32-44. This is also made clear by the bi-directional arrows shown on the second stage 5 of *Tsuda*. Thus, *Tsuda* does not teach every element of the rejected claims.

Since *Tsuda* does not teach the apparatus being claimed in this application, Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be withdrawn.

The Applicants also note that the Examiner has failed to address the elements of independent claim 29. For example, claim 29 recites the element, “a component mount configured to mount a device at or near the rotational center of the alignment carriage.” The

¹ Because *Tsuda* is only citable under 35 U.S.C. § 102(e) Applicants do not admit that *Tsuda* is in fact prior art to the claimed invention but reserve the right to swear behind *Tsuda* if necessary to remove it as a reference.

Examiner has failed to address this element of claim 29. As such, a *prima facie* case of anticipation has not been set forth with regard to this claim and those which depend therefrom.

Notwithstanding the failure to present a *prima facie* case of anticipation regarding 29, the Applicants note that *Tsuda* does not teach this element as well. For example, the *Tsuda* clearly holds elements b at holding section 4. It is clear from Figures 1-3 that element b is not located at or near a rotational center of the alignment carriage. *See also* col. 5, lines 25-30. Thus *Tsuda* does not teach each element of claim 29 and the rejection of claims 29-34 should be withdrawn.

Regarding claim 1, the Applicants also note that the Examiner has not applied the proper analysis under 35 USC 112-6th paragraph. For example, the Examiner has not established that the *Tsuda* teaches the element, “means for engaging the at least one rotation paddle to selectively rotate the alignment carriage” [emphasis added] in combination with every other element of claim 1. MPEP 2181-2183. According to MPEP 2181 Section I, “[a] claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase “means for” or “step for;”
- (B) the “means for” or “step for” must be modified by functional language; and
- (C) the phrase “means for” or “step for” must not be modified by sufficient structure, material or acts for achieving the specified function.”

35 U.S.C. 112, sixth paragraph is invoked for the above element of claim 1 because the element uses the phrase “means for,” which is modified by the functional language “engaging the at least one rotation paddle to selectively rotate the alignment carriage” and is not modified by sufficient structure for the claim function. The Applicant’s disclosure provides structural support for such functional limitation, examples of which are illustrated in Figures 1-7 and the corresponding discussion.

After the Patent Office has identified the corresponding structure support in the Applicant’s specification the Patent Office must point to equivalent corresponding structure in the Prior Art. The Applicant requests that all mean-plus-function elements of the claims be addressed according to MPEP 2181-2183 and 35 U.S.C. 112 paragraph 6. Because every element of claim 1 has not been addressed as required for a *prima facie* case of anticipation, the Applicant respectfully requests that the rejection of claim 1 be withdrawn for this reason as well.

B. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 8, 15, 26, and 34 under 35 U.S.C. § 103 as being unpatentable over *Tsuda*.

The Applicant respectfully traverses the Examiner's assertion that use of contact points being composed of a metallic material for the purpose of solid alignment of the device is sufficiently old and well known in the art for the Examiner to take Official Notice. The Applicants hereby make a seasonable challenge to the Official Notice made by the Examiner.

The Applicants also note that the Examiner has relied upon case law for rejecting claims 9, 15, 26 and 34 but the Examiner has failed to demonstrate that the facts of the case law are sufficiently similar to those of this application as required by MPEP 2144. As such the rejection of claims 8, 15, 26, and 34 should be withdrawn.

Notwithstanding the failure to present a *prima facie* case of obviousness, claim 8 depends from claim 1, and claims 15, 26, and 34 depend from claim 9. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As such, the Applicants respectfully request the rejection of claims 8, 15, 26, and 34 be withdrawn at least for the same reasons as claim 1 or 9.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 13th day of November, 2006.

Respectfully submitted,

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